

R E M A R K S

The last Official Action (Paper No. 11 dated December 18, 2002) has been punctiliously considered.

Applicants have decided to carefully amend the twice amended claim 1 in an effort to more accurately distinguish over the teaching of US patent No. 6,022,353 to Fletcher et al. (hereinafter called Fletcher for short). The preamble of the thrice amended claim 1 recites that the improved tool is to be used for the making of cuts in workpieces, namely to make cuts having predetermined widths and bounded by walls. In other words, applicants provide a tool and an apparatus for making cuts which are bounded by walls so as to have predetermined widths. This plainly departs from the teaching of Fletcher who discloses and claims a surgical saw blade for use in combination with a surgical bone saw (please refer to the lines 1-2 of the claim 1 in this patent).

First of all, it is not likely that a person having the proverbial ordinary skill in the art of surgery would consider a bone cutting saw blade as a device suitable for the making of cuts (such as slits) of predetermined width. Secondly, it is also highly unlikely that a person who is to make slits in workpieces (empha-

sis by the undersigned attorney) would be likely to seek ideas in the field of bone cutting. Webster's Third International Dictionary defines a workpiece as "a piece of work in the process of manufacture", i.e., a commodity which evidently excludes a bone, be it a human bone or that of another animal being. Thirdly, it is well settled that the preamble of a US patent claim must be fully considered when judging on the merits of the claim. Please refer, for example, to the decision of the Court of Appeals for the Federal Circuit in *Diversi-tech Corp. v. Century Steps, Inc.* (850 F.2d 675, 7 USPQ2d 1315) wherein it was held as follows:

"The district court correctly found that the preamble of the claim was necessary to give meaning to the claim and therefore constituted an essential limitation in determining whether the claim was anticipated."

Thus, the preamble of the newly presented thrice amended independent claim 1 by itself suffices to warrant withdrawal of the rejection of the twice amended claim 1 under 35 USC §102 in paragraphs 2-3 on pages 2-3 of Paper No. 11.

Full support for the present formulation of the preamble of applicants' latest version of the independent claim 1 can be found, for example, in lines 7 through 19 on page 5 of applicants' original specification.

The body of the thrice amended claim 1 further distinguishes over the teaching of Fletcher by reciting that the second section of the tool (e.g., the tool 11 shown in Figs. 1 to 4 of applicants' drawing) has an elongated cutting edge (13) which is arranged to make in a workpiece a cut having a width which is a function of several parameters, namely (a) the extent of oscillatory movement of the output shaft 7, (b) the distance L from the axis A to the cutting edge 13, and (c) the length B of the cutting edge 13. Full support for such language can be found (practically *ipsisssimis verbis*), for example, in lines 5-18 on page 15 of applicants' specification.

None of the just enumerated features of applicant's thrice amended claim 1 are disclosed, or even remotely suggested, within the four corners of the Fletcher reference. This stands to reason since the patentees are concerned with the severing of (i.e., not with the making of cuts of predetermined width in) normally round or substantially round objects (bones). As can be readily seen in Fig. 5b of the Fletcher patent, the length of the cutting edge at the distal end of the saw blade 10 must at least match the maximum transverse dimension of the bone which is to be severed. This appears to be shown in Fig. 5b of the Fletcher patent whe-

rein the (non-referenced) topmost part appears to be a bone. Furthermore, Fig. 5b of Fletcher shows the kerf 33 which appears to be shorter than the length of the toothed edge (stairs) 31 at the distal end of the blade 30. This stands to reason since a kerf being made by a saw must be shorter than the combined length of the teeth if the saw is to be capable of cutting across a bone, a tree trunk or any other object which is to be cut by a saw. Please refer to the definition of "kerf" in Webster's Dictionary.

The claims 2, 3, 6, 9, 10 and 15-17 are believed to be patentable because they refer to and thus share the features of the presumably allowable new independent claim 1.

The rejection of claims 12 and 13 as being anticipated by the disclosure in the patent to Fletcher is believed to warrant careful reconsideration. More specifically, the statement in the last paragraph on page 2 of Paper 11, namely that "Fletcher et al. teaches a slot, 24, provide (sic!) for facilitating removal of cut material, provided in the elongated member between the first and second sections", appears to contradict the actual disclosure in the patent to Fletcher. Please refer to the paragraph in lines 42-49 in col. 4 of this reference where the patentees state that the "diamond-

shaped cutout 24" serves to reduce the weight of the blade 10 and that it assists in tooth profiling during fabrication. Therefore, applicants have decided to replace the claim 12 with an independent claim 21 which recites all features of the twice amended claim 1 and of the original claim 12, and to make the claims 13 and 14 dependent upon the new claim 21.

The claims 4 and 5 are believed to be patentable because they refer to the thrice amended claim 1. Therefore, applicants assume that the patent to Arntz et al. (please refer to paragraph 4 on page 3 of Paper No. 11) need not be discussed at this time.

The rejection of claims 7 and 8 in paragraph 5 on pages 3-4 of Paper No. 11 need not be discussed because these claims also refer to the presumably allowable thrice amended claim 1.

The claim 11 refers to the thrice amended claim 1; therefore, the patent to Nitz et al. (please see the paragraph 6 on page 4 of Paper No. 11) need not be discussed at this time.

Applicants believe that the rejection of claim 14 as being unpatentable over the combined teachings of Fletcher and Miller et al. (please refer to paragraph 7 on pages 4-5 of Paper No. 11) warrants full reconsideration. Attention is respectfully invited to col.

4, lines 40-43 of Miller et al. where the patentees state that the opening(s) 54 serves or serve to reduce the weight of the blade 50. Thus, the teaching of this reference appears to be just as irrelevant as the afore-discussed teaching in col. 4, lines 42-49 of Fletcher.

Applicants respectfully request careful reconsideration of the rejection of claims 18-20 as being unpatentable over the combined teachings of Fletcher and Fisher. These references are believed to belong to entirely different fields of inventive endeavor. Please compare the different US Classes as well as International Classes to which these references belong. This stands to reason since Fletcher proposes the provision of a saw blade for cutting across bones whereas Fisher proposes to provide a power tool for use with tool bits such as scrapers, chisels and spades (please refer to col. 1, lines 10-14 of the secondary reference). Furthermore, Fletcher proposes to use a saw blade with an oscillatory power tool; on the other hand, Fisher proposes to employ a power tool in combination with a lengthwise reciprocating scraper bit or the like (please refer, for example, to lines 8-9 of the Abstract in the patent to Fisher). This must have been realized by the US Patent and Trademark Office since Fletcher belongs to US Class 606 (International Class A61B)

whereas Fisher belongs to US Class 173 (International Class B25D). Reconsideration of the rejection and allowance of the claims 18-20 are respectfully urged.

A careful review of the non-applied references which are enumerated in paragraph 9 on page 6 of Paper No. 11 reveals that they are less relevant than the afo-rediscussed prior art.

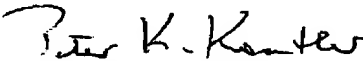
The Examiner's decision to proceed in a manner as expounded under the heading Response to Arguments on page 6 of Paper 11 is gratefully acknowledged.

This Paper is believed to place the present application in condition for allowance with the claims 1 to 11 and 13-21, and such disposition at a reasonably early date is earnestly solicited.

Respectfully submitted,

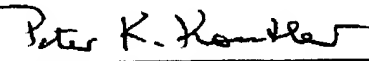
Dated: March 10, 2003

Enclosure:
Appendix (pp. A-C)



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I hereby certify that this amendment was forwarded to the US Patent and Trademark Office by facsimile on March 10, 2003 (to facsimile No. (703) 872 9303).



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APPENDIX to Amendment in re application Serial No.
09/917,998 filed July 30, 2001 by Marco STEIGER et al.
for "MATERIAL REMOVING TOOL"
Group Art Unit 3723
Examiner Ms. Shantese L. McDonald

The following is a marked up version of the thrice amended
claim 1 as it appears in the enclosed Amendment filed in
response to the Official Action of December 18, 2002:

1 1. A tool for [removal of material from] making in
2 workpieces cuts having predetermined widths and bounded
3 by walls with a manually operable apparatus having a
4 power driven output shaft arranged to oscillate about
5 a predetermined axis, comprising:
6 an elongated member having a first section arrang-
7 ed to be mounted on said output shaft so that the member
8 extends in a direction at least substantially normal
9 to said predetermined axis; and
10 a second section remote from said first section
11 and including at least one at least substantially
12 straight elongated cutting edge at least substantially
13 normal to said direction and arranged to make in a work-
14 piece a cut having a width which is a function of the
15 extent of oscillatory movement of said output shaft,
16 of the distance from said axis to said cutting edge and
17 of the length of said cutting edge.

The following are marked up versions of the amendeded claims 13-14 and of the new claim 21 as they appear in the enclosed Amendment filed in response to the Official Action of December 18, 2002:

1 13. The tool of claim [12] 21, wherein said remov-
2 al facilitating means comprises at least one slot
3 provided in said elongated member and extending between
4 said first and second sections.

1 14. The tool of claim [12] 21, wherein said at
2 least one cutting edge has first and second ends and
3 said removal facilitating means comprises recessed por-
4 tions at said ends of said at least one cutting edge
5 intermediate said first and second sections.

1 21. A tool for removal of material from workpieces
2 with a manually operable apparatus having a power driven
3 output shaft arranged to oscillate about a predetermined
4 axis, comprising:

5 an elongated member having a first section arrang-
6 ed to be mounted on said output shaft so that the member
7 extends in a direction at least substantially normal
8 to said predetermined axis;

9 a second section remote from said first section
10 and including at least one at least substantially
11 straight cutting edge at least substantially normal to

- B -

12 said direction; and
13 means for facilitating removal of material from
14 a workpiece being cut by said cutting edge.

- C -